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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/593,316  | 09/18/2006  | Yvonne Heischkel            | 295796US0PCT        | 7016             |
| 22850 7590 04/25/2011<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                             |                     |                  |
| EXAMINER<br>BALASUBRAMANIAN, VENKATARAMAN   |             |                             |                     |                  |
| ART UNIT<br>1624  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>04/25/2011   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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### **ADVISORY ACTION**

The applicants' response filed 04/13/2011 under 37 CFR 1.116 in reply to the final rejection along with a Terminal Disclaimer has been considered but is not deemed to place the application in condition for allowance for the following reasons. Although, the Terminal Disclaimer overcame the double patenting rejection made in the previous office action, the amendment to claim 4 has resulted in new grounds of rejections.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 9, 13, 14, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 4 is indefinite as it is vague and unclear as to what is claimed as composition. As recited, it is not clear whether claim 4 relates to a composition of the reaction mixture of reactants, products and solvents of the process of making comprising the radiation curable 1,3,5-triazine carbamates of formula I, II or III or simply a composition with undefined additional ingredients comprising the radiation curable 1,3,5-triazine carbamates of formula I, II or III. Claim 4 as recited is clearly ambiguous.
2. Claim 5 is an improper dependent claim. Claim 5 fails to further limit claim 4 on which it is dependent. First, claim 5 recites "A radiation curable 1,3,5-triazine carbamates according to claim 4", but claim 4 is no longer a product claim. Claim 4 as amended is undefined composition claim as noted above. Hence, the scope of claim 5

does not match with the scope of claim 4. Second, claim 5 recites "polyether (meth)acrylates, polyesterol(meth)acrylates, urethane(meth)acrylates and epoxy(meth)acrylates" which are not in the scope of claim 4. Hence, the scope claim 5 is broader than claim 4. Claim 5 is hence an improper dependent claim.

3. Claim 9 is an improper dependent claim. Claim 9 fails to further limit claim 4 on which it is dependent. First, claim 9 recites "at least one radiation curable 1,3,5-triazine carbamates according to claim 4", but claim 4 is no longer a product claim. Claim 4 as amended is undefined composition claim as noted above. Hence, the scope of claim 9 does not match with the scope of claim 4.

4. Claim 13 is a duplicate of amended claim 4, if claim 4 is rewritten as composition of the product.

5. Claim 14 is a duplicate of amended claim 4, if claim 4 is rewritten as composition of the product.

6. Claim 25 is an improper dependent claim. Claim 25 fails to further limit claim 4 on which it is dependent. First, claim 25 recites "the radiation curable 1,3,5-triazine carbamates according to claim 4", but claim 4 is no longer a product claim. Claim 4 as amended is undefined composition claim as noted above. Hence, the scope of claim 25 does not match with the scope of claim 4.

7. Claim 26 is an improper dependent claim. Claim 26 fails to further limit claim 4 on which it is dependent. First, claim 9 recites "the radiation curable 1,3,5-triazine carbamates according to claim 4", but claim 4 is no longer a product claim. Claim 4 as

amended is undefined composition claim as noted above. Hence, the scope of claim 25 does not match with the scope of claim 4.

***Double Patenting***

Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4, if claim 4 is rewritten as a composition of radiation curable 1,3,5-triazine carbamates. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4, if claim 4 is rewritten as a composition of radiation curable 1,3,5-triazine carbamates. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4, if claim 4 is rewritten as a composition of radiation curable 1,3,5-triazine carbamates. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

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/Venkataraman Balasubramanian/  
Primary Examiner, Art Unit 1624

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